

REMARKS

Claims 18-22 and 24-27 are pending in the instant application. In the interest of expediting the prosecution of the instant application, applicants amend claim 18 as shown above, which incorporates the limitation of the now-canceled claim 23.

Rejections under 35 U.S.C. 102

The Examiner maintains the rejection of claims 18-21 and 23-26 under 35 U.S.C. §102(a) as being anticipated by Fodor, *et al.*, (*Science*, February 15, 1991, 251:767-773) and the rejection of claims 18-27 under 35 U.S.C. 102(e) as being anticipated by Pirrung, *et al.* (U.S. Patent No. 5,143,854). Applicants respectfully traverse these rejections.

Neither Fodor nor Pirrung teaches a solid support where the support surface of the functionalized site has a higher surface tension relative to the support surface surrounding the functionalized site. Applicants respectfully request the withdrawal of the 102 rejections based on Fodor and Pirrung.

To argue inherency, the Examiner must meet the requirements set forth in MPEP §2163.07, which states that “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the things described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” (citing *In re Robertson* 169 F.3d 743, 745 (Fed. Cir. 1999)). The Examiner has not met the MPEP requirement for establishing inherency. First, the Examiner cites no extrinsic evidence that makes clear the missing surface tension characteristics are necessarily present in Fodor or Pirrung. Even if the Examiner could argue that the surfaces in Fodor or Pirrung have some level of surface tension. None of these references teaches the surface at a functionalized site has a higher surface tension relative to the surface surrounding the functionalized site. Second, persons of ordinary skill would not recognize that Fodor or Pirrung necessarily uses higher surface tension to separate solutions at functionalized sites. In fact, the Fodor or Pirrung reference describes a photolithographic method, which employs various masks for photoactivation (for example, page 767 of Fodor and columns 11-20 of Pirrung). In other words, persons of ordinary skill in the art would not recognize that using higher surface tension to separate solutions at functionalized sites is

necessarily present in Fodor or Pirrung's solid support fabricated by photolithography. Because the Examiner did not establish inherency as required in MPEP, applicants respectfully request the withdrawal of the 102 rejections based on Fodor or Pirrung.

Double Patenting Rejection

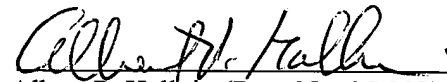
Claims 18-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 of U.S. Patent No. 5,985,551. Applicants are prepared to submit a Terminal Disclaimer when claims in the instant application are in condition for allowance.

CONCLUSION

In view of the foregoing, applicants believe that the claims in the instant Application are in condition for allowance and advancement as such is earnestly requested. If, in the opinion of the Examiner, a telephonic interview would expedite the prosecution of the subject Application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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